

### **REMARKS**

In view of the Appeal Brief filed on November 4, 2005, the Examiner reopened prosecution by providing the Office Action mailed on April 18, 2006. Claims 1-32 stand rejected. Reconsideration of the application is respectfully requested.

On a preliminary note, Applicants stress that the references cited by the Examiner in the Office Action mailed on April 18, 2006 have already been asserted in previous rejections that the Examiner eventually withdrew. Indeed, in this most recent Office Action, the Examiner based his rejections solely on two references (i.e., Kim (U.S. Patent No. 5,181,029) and Rosenberg (U.S. Patent No. 6,693,626)) that Applicants have already successfully argued are deficient with respect to previous rejections. *See e.g.*, Office Action mailed October 6, 2003 (rejecting claims based on Powers et al. in view of Kim and Comer), Response to the Office Action mailed October 6, 2003 (distinguishing Kim over the claim features), Office Action mailed September 21, 2004 (rejecting claims based on Powers et al. in view of Acevedo and Rosenberg), and Response to the Office Action mailed September 21, 2004 (distinguishing Rosenberg over the claim features). Further, in this most recent Office Action, the Examiner has failed to substantively address all of the Applicant's previous arguments with regard to the deficiencies of the cited references. Accordingly, deficiencies of the cited references, which have already been set forth throughout the prosecution history, are reiterated below.

Further, Applicants stress that the Examiner is unnecessarily prolonging prosecution by continually going back to references that have already been cited in support of rejections that have already been withdrawn. Accordingly, Applicants respectfully remind the Examiner of the Examiner's duties under 37 C.F.R. § 1.104. Specifically, the Examiner is required to

“make a thorough investigation of the available prior art relating to the subject matter of the claimed invention.” 37 C.F.R. § 1.104(a). Additionally, if the Examiner rejects a claim for want of novelty or for obviousness, the Examiner “must cite the *best* reference at his or her command.” 37 C.F.R. § 1.104(c)(2) (emphasis added).

### **Rejections Under 35 U.S.C. § 102**

The Examiner rejected claims 1-3 and 5 under 35 U.S.C. § 102(b) as being anticipated by Kim (U.S. Pat. No. 5,181,029). With regard to independent claim 1, the Examiner stated:

Regarding claim 1, Kim teaches a user-configurable keyboard (see Fig. 1 (20)) comprising: a display configurable to display a plurality of icons; (LCD screen (70), icons may be displayed within each of the designated areas, see Fig. 1 (70) and col. 3, lines 55-60) and a plurality of keys corresponding to the plurality of icons (an area on the LCD screen (70) is designated for each of the function key (50) so that each of the designated areas is proximate to the function key (50), see col. 3, line 44-48) and configurable to launch one of a software program (a program selector (80) is used to select the desired software program and a user may assign a specified series of keystrokes to a given function key. In PROGRAM mode, the user is able to define or reconfigure a function key using the appropriate keystrokes necessary to perform the desired functions, see col. 3, lines 64-66 and col. 4, lines 9-21).

Note that a keyboard template (10)(overlaid onto the computer keyboard (20)) is an integral part of the overall keyboard structure shown in Fig. 1

Also note that given the way the claim is written, the examiner considers only one of the last two limitations, and hence excludes the limitation stating “a Uniform Resource Locator corresponding to a respective icon.”

Office Action, pages 2-3.

Applicants respectfully traverse this rejection. Anticipation under 35 U.S.C. § 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under 35 U.S.C. § 102, every element of the claimed invention

must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under 35 U.S.C. § 102, a single reference must teach each and every element or step of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Thus, if the claims contain even one recitation not found in the cited reference, the reference does not anticipate the claimed subject matter.

The present application is directed to a method and apparatus for displaying a plurality of icons on a user configurable keyboard to allow users to launch applications and uniform resource locators (URLs) that are displayed as icons on the keyboard. The keyboard includes a display screen, such as a liquid crystal display (LCD), for displaying user configurable icons proximate to a set of launch keys. Page 12, line 22 - page 13, line 2. The display screen on the keyboard may comprise any suitable display medium. Page 13, lines 2-3. The launch keys are user configurable to allow a user to program the desired application program invocation or URL in the computer system memory circuitry. Page 13, lines 3-6. Accordingly, independent claim 1 recites “[a] user-configurable keyboard comprising: a display configurable to display a plurality of icons.”

The Kim reference discloses a template 10 having an LCD screen 70 that allows letters, words or graphics (e.g. icons) to be displayed within each of a group of designated 50-pixel by 50-pixel areas. Col. 3, lines 21-29 and 56-64. Each designated area may correspond to function keys 50 proximate to each designated area. Col. 3, lines 44-48. Accordingly, the LCD screen 70 may list various functions that may be invoked, and further may associate each of the functions with a key icon. *See* col. 3, lines 60-63. However, in sharp contrast to the claimed invention, the LCD screen 70 of the Kim reference is clearly *not* part of the keyboard.

Instead, the LCD screen 70 is provided on an electronic keyboard template 10, which is merely overlaid onto a computer keyboard 20. Col. 3, lines 21-29. Accordingly, the Kim reference does not disclose a *keyboard* comprising a display configurable to display a plurality of icons, as recited in claim 1. At best, Kim discloses providing designations for a portion of the keyboard (e.g., function keys) on an LCD screen display 70 on a component that is *separate from* the keyboard.

In the Office Action, the Examiner stated that “a keyboard template (10)(overlaid onto the computer keyboard (20)) is an integral part of the overall keyboard structure shown in Fig. 1. Office Action, page 3. However, the Examiner’s statement does not make sense. An *integral* part of the *keyboard* cannot be “*overlaid onto*” the *keyboard*. See Kim, col. 3, line 25 (emphasis added). In other words, a component would not be overlaid onto itself. Further, the figures of the Kim reference plainly illustrate the keyboard 20 and template 10 as separate components. Accordingly, Applicants assert that the description and illustrations set forth in the Kim reference clearly support the assertion that the template 10 is *separate* from the keyboard 20. In fact, it appears that the Kim reference actually makes it a point to emphasize that the template is *separate* from the keyboard. See col. 3, lines 25-33. Thus, again, Applicants stress that the Kim reference does not disclose a keyboard *comprising* a display.

In view of the remarks set forth above, Applicants respectfully submit that Kim fails to disclose each and every recited feature of claim 1. Thus, Kim does not anticipate independent claim 1 or the claims depending therefrom. Accordingly, Applicants respectfully request withdrawal of the rejection of independent claim 1, and an indication of allowance for claim 1. Further, Applicants request that the Examiner withdraw the rejection of dependent claims 2, 3

and 5 based on their dependency from claim 1 and for unique matter recited in each dependent claim, and provide an indication of allowance for claims 2, 3, and 5.

### **Rejections Under 35 U.S.C. § 103**

The Examiner rejected claim 4 under 35 U.S.C. § 103(a) as being obvious over Kim. Additionally, the Examiner rejected claims 6-32 under 35 U.S.C. § 103(a) as being obvious over Rosenberg (U.S. Patent No. 6,693,626) in view of Kim. The Examiner's rejections are too lengthy to be reproduced efficiently herein. However, Applicants respectfully traverse these rejections.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (P.T.O. Bd. App. 1979). To establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (Bd. Pat. App. & Inter. 1985).

Regarding the rejection of claim 4, Applicants stress that claim 4 is dependent from claim 1. Accordingly, Applicants assert that claim 4 is currently in condition for allowance based on the arguments set forth above with respect to independent claim 1.

Regarding the rejection of independent claim 6, Applicants assert that the references cited by the Examiner, whether considered separately or in a hypothetical combination, do not disclose every claimed feature. For example, independent claim 6 recites a “keyboard comprising: *a display configurable to display a plurality of icons*”. (Emphasis added). The

Examiner admitted that Rosenberg failed to disclose a “keyboard comprising: a display configurable to display a plurality of icons.” *See* Office Action, pages 5-6. However, in the rejection of claim 6, the Examiner relied on Kim for its alleged disclosure of these features. *Id.* Applicants stress that *both* Rosenberg *and* Kim fail to disclose these recited features. Again, as set forth above with respect to claim 1, the Kim reference does not disclose a keyboard *comprising* a display. Specifically, the LCD screen 70 of the Kim reference is clearly *not* on the keyboard. Instead, the LCD screen 70 is provided on an electronic keyboard template 10, which is merely overlaid onto the separate computer keyboard 20. Col. 3, lines 21-29. Accordingly, the Examiner has not established a *prima facie* case of obviousness with respect to claim 6 because all of the recited features are not present in the cited references.

Regarding the rejection of independent claims 15 and 23, Applicants assert that the references cited by the Examiner, whether considered separately or in a hypothetical combination, do not disclose every claimed feature. For example, claims 15 and 23 each recite, “*transmitting the icon from the monitor to a keyboard.*” (Emphasis added). In the Office Action, the Examiner relied on Rosenberg for its alleged teaching of this feature. *See* Office Action, pages 7-10. However, Applicants assert that Rosenberg is actually deficient with respect to this feature. Further, the Applicants assert that Kim does not remedy the deficiencies of Rosenberg. Indeed, Kim was merely cited by the Examiner for its alleged teaching of “screen LCD (70) extending above function keys (50).” *See* Office Action, pages 8 and 10. Thus, as recognized by the Examiner, the Kim reference does not disclose or support “transmitting [an] icon from [a] monitor to a keyboard,” as recited in claims 15 and 23. However, contrary to the Examiner’s assertions, the Rosenberg reference fails to disclose these features as well.

As indicated above, embodiments of the present invention are directed to launch keys that are user configurable to allow a user to program the desired application program invocation or URL in the computer system memory circuitry. Page 13, lines 3-6. Accordingly, claims 15 and 23 recite, “selecting an icon from a system monitor ... *transmitting the icon from the monitor to a keyboard* ... displaying the icon on the keyboard.” (Emphasis added). Rosenberg fails to disclose “transmitting the icon from the monitor to a keyboard” as recited in claims 15 and 23.

Rosenberg “is directed to a haptic keyboard device that allows the user to experience haptic feedback when using the keyboard ... [which] allows the user to provide input to a computer system and experience haptic feedback when typing and otherwise inputting information using a keyboard.” Rosenberg, col. 2, lines 6-12. Appellants respectfully submit that there is nothing in Rosenberg that can be accurately characterized as transmitting an icon from a monitor to a keyboard. Rosenberg simply discloses a haptic keyboard device which allows a user to interact with a computer. There is nothing in Rosenberg to suggest that the haptic keyboard device could be implemented or modified to transmit an icon from a monitor to a keyboard, as recited in claims 15 and 23. Appellants assert that because the Rosenberg reference does not even disclose transmitting an icon to a keyboard, it cannot possibly disclose “selecting an icon from a system monitor,” “transmitting the icon from the monitor to a keyboard,” and then “displaying the icon on a keyboard,” as recited in claims 15 and 23. Accordingly, the Examiner has not established a *prima facie* case of obviousness with respect to claims 15 and 23, because all of the recited features are not present in the cited references.

Neither of the cited references either alone or in combination discloses each of the elements recited in independent claims 6, 15, and 23, much less provide any motivation or suggestion to combine these teachings in the manner recited in the present claims.

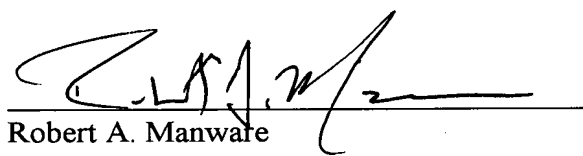
Accordingly, Applicants respectfully request withdrawal of the Examiner's rejection and allowance of claims 6, 15 and 23, as well as the claims dependent therefrom.

### **Conclusion**

In view of the remarks set forth above, Applicants respectfully request allowance of claims 1-32. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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Robert A. Manware  
Reg. No. 48,758  
(281) 970-4545

**HEWLETT-PACKARD COMPANY**  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, Colorado 80527-2400